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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/614,183	07/08/2003	Erin Jessica Lindsay	033528-001	7109

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EXAMINER

FOSTER, MARLEE CHRISTINE

ART UNIT	PAPER NUMBER
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3731

DATE MAILED: 06/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/614,183

Applicant(s)

LINDSAY, ERIN JESSICA

Examiner

Marlee C. Foster

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 15 October 2003.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities: In paragraph 0026, line 4; the application should state "fork arms" instead of "form arms".

Appropriate correction is required.

Claim Objections

2. Claims 6 and 9 are objected to because of the following informalities: "form arm" should be "fork arm". Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 11 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 11 recites "said at least one manipulator fork comprises two manipulator forks". This language implies that multiple manipulator forks extend from a single manipulator fork. Based on the specification and as shown in Figures 1 and 7, two separate manipulator forks are disclosed, each having a fork swivel control tube, fork arm, and a contour fork surface. The Examiner suggests changing this language to read "at least two manipulator forks".

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-5 and 11 are rejected under 35 U.S.C. 102(e) as being anticipated by Bayer (US 2004/0204725). Bayer discloses, in the figures, a surgical apparatus with an endoscopic barrel (12) with a plurality of lumens for housing ligating and cauterizing instruments within the apparatus (Figure 10), a handle (136 and 138) disposed at the proximal end of the barrel, and a conical tip (100) at the distal end of the barrel. A manipulator fork is extendable from the cone portion of the instrument (Figure 8). Regarding claims 2 and 4, the cone portion of the apparatus contains a recess (120) for receiving the manipulator fork and additional surgical instruments (Figure 3). Bayer discloses handles (134a and 134b) that control axial and rotational movement of the manipulator fork. A ball-like actuator within a track (31b) controls the instruments used for ligation and cutting. Regarding claim 11, Bayer shows three lumens in the apparatus, and one manipulator fork comprising two manipulators (Figure 10).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. Claims 6-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bayer (US 2004/0204725) in view of Haber et al. (US 5,282,806). Bayer discloses the invention substantially as claimed, but does not disclose the manipulator fork arm and a distal fork controlled by a swivel control ring disposed on the handle. Haber et al. disclose, in Figure 1, a manipulator fork comprising a distal fork and a fork arm. Haber et al. teach a swivel control ring (78) disposed on the handle that controls the swiveling of said manipulator fork. A swivel control tube (8) is disposed on the fork arm to cause the manipulator rotate when the swivel control ring is engaged (col.5, lines 52-55). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made, in view of Haber et al., to include a swivel control ring and a swivel control tube to rotate the manipulator fork in the device of Bayer. A swivel control ring assembly would increase the ease of controlling the manipulator forks within a plurality of surgical instruments.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Lindsay (US 6,660,016), Koros et al. (US 5,352,235), and

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Privitera et al. (US 5,569,291) teach similar endoscopic instruments with cutting tips disposed on the distal end, control mechanisms on a slidable track or wheel, and handles for actuating movement of the cutting tips.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marlee C. Foster whose telephone number is (571) 272-5072. The examiner can normally be reached on Monday to Friday 8:00 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan Nguyen can be reached on (571) 272-4963. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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SUPERVISORY PATENT EXAMINER
5/26/06